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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.           | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------------|------------------|
| 10/760,251   | 01/21/2004  | Kia Silverbrook      | WAL11US                       | 3252             |
| 24011  | 7590        | 03/10/2005           |                               |                  |
| SILVERBROOK RESEARCH PTY LTD<br>393 DARLING STREET<br>BALMAIN, 2041<br>AUSTRALIA |             |                      | EXAMINER<br>NGUYEN, ANTHONY H |                  |
|  |             |                      | ART UNIT<br>2854              | PAPER NUMBER     |

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/760,251

Applicant(s)

SILVERBROOK ET AL.

Examiner

Anthony H. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17, 18 and 21-49 is/are rejected.
- 7) ☒ Claim(s) 16, 19 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/12/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

#### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

The information disclosure statement filed 01/21/2004 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. The information disclosure statement filed 01/21/2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of

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each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. Specifically, the reference FR 2604120 A1 is not provided.

### ***Specification***

The disclosure is objected to because of the following informalities: the print head is assigned to both numeral references "320" and "500" (page 39). Appropriate correction is required.

### ***Claim Objections***

Claims 1-49 are objected to because it is unclear which element the term "it" (claims 1 and 31, line 7, claim 11 line 2, claim 47 line 3) is referred to. Also, the language "can be" (claim 20, line 3), "may be" (claim 32, line 2) is not a positive claim language.

With respect to claim 38-43 and 49, these claims are objected to because the dependency of these claims is improper. It is improper to mix statutory classes of invention except for certain very limited cases such as product by process invention.

To the extent the claims are definite and a positive recitation of the structure, it appears that the following prior art rejection is proper.

***Claim Rejections - 35 U.S.C. § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,7, 12, 17 and 44,are rejected under 35 U.S.C. 102(b) as being anticipated by Martin (US 2002/0171692 A1).

Martin . teaches a printer 18 for producing rolls of wallpaper having a frame (no numeral reference), a print head 20 located across the media path, an input devices 36, 37, a processor 38 and a winding area 18, 26.

***Claim Rejections - 35 U.S.C. § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 36 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Martin (US 2002/0171692 A1) in view of Sandhoo (DE 29908649-U1)).

Martin teaches the printer for producing rolls of wallpaper having substantially the structure as recited. See the explanation of Martin above. Martin does not teach the dryer located between the printhead and the winding area for drying the printed medium. Sandhoo teaches the conventional dryer (no numeral reference) located between the printing area 4 and the winding area 6 for drying the printed web 8. In view of the teaching of Sandhoo, it would have been obvious to one of ordinary skill in the art to modify the printer of Martin by providing the dryer as taught by Sandhoo for quickly drying of a printed web.

Claims 3, 6, 9, 10, 31-33 and 48 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Martin (US 2002/0171692 A1) in view of Schoendienst et al. (US 5,302037).

Martin teaches the printer for producing rolls of wallpaper having substantially the structure as recited. See the explanation of Martin above. Martin does not teach the cutting mechanism located between the printhead and the winding area for cutting the printed web from a wound portion. Schoendienst et al. teaches the cutting mechanism 64 located between the print head (PH) and the winding area 50 as shown in Fig.5a of Schoendienst et al. In view of the teaching of Schoendienst et al. , it would have been obvious to one of ordinary skill in the art to modify the the printer of Martin by providing the cutter as taught by Schoendienst et al. to facilitate maintenance operation of the cutter. With respect to claim 6, Schoendienst et al. teaches the well

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or the space between the door 50 and the frame 30 and adjacent to an exit slot 65 (Schoendienst et al., Figs.1-1b). With respect to claims 9 and 10, Schoendienst et al. teaches the use of the loading area for store the media supply rollers (SR) and the take-up roller (TR) and cutting mechanism 64 as shown in Fig.5a of Schoendienst et al.). With respect to claim 48, Note that Martin teaches the use of a drive roll 28 for feeding the web 27 out of the slot (Martin, Fig.1); and Schoendienst et al. (Fig.1f) teaches the conventional use of a motor (M) within the cabinet for advancing the web out of the media cartridge (SR) via a take-up spindle 110 and the motor (M) .

Claims 4,,35 and 46 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Martin (US 2002/0171692 A1) in view of Schoendienst et al. (US 5,302037) and Kwasny et al. (US 2002/0118990).

Martin teaches the printer for producing rolls of wallpaper having substantially the structure as recited. See the explanation of Martin and Schoendienst et al. above. Martin and Schoendienst et al. do not teach the slitting mechanism for slitting a media web. Kwasny et al. teaches the cutter mechanism 14 which cuts transversely media web 18 and slitting mechanism 16 which slices longitudinally the media web as shown in Fig.2. In view of the teaching of Kwasny et al., it would have been obvious to one of ordinary skill in the art to modify the printer of Martin and Schoendienst et al. by providing the slitting mechanism as taught by Schoendienst et al. to improve the efficiency of cutting a web into multiple narrow webs after printing.

Claim 5 is rejected under 35 U.S.C. § 103 (a) as being unpatentable over Martin (US 2002/0171692 A1) in view of Lem et al. (US 2003/0116747).

Martin teaches the printer for producing rolls of wallpaper having substantially the structure as recited. See the explanation of Martin above. Martin does not teach the bar code scanner which communicates with the processor. Lem et al. teaches the conventional use of a bar code scanner 230 to input data to a processor 240. In view of the teaching of Lem et al., it would have been obvious to one of ordinary skill in the art to modify the printer of Martin by providing the bar code scanner as taught by Lem et al. for ease and quickly entering data to the processor.

Claims 8, 21-30, 37,38-43, 45 and 49 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Martin (US 2002/0171692 A1).

With respect to claim 8, Martin teaches all that is claimed, except for the video display which is a touchscreen. However, the use of touchscreen for selection the items shown on the video display is conventional. It would have been obvious to one of ordinary skill in the art to provide a conventional touchscreen in Martin for ease of entering data into a printer. With respect to claims 21-30, the selection of a desired rate at which the print head prints on a medium or the selection of the number of nozzles or number of ink drops for each of the print head would be obvious through routine experimentation in order to get best possible print quality. With respect to claims 38-43 and 49, Martin renders obvious the broad steps of utilizing an on-demand printer, using one or more input devices, using the processor to control the printer and printing a roll of wallpaper according to a selected pattern.



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Claims 11-15, 17 and 47 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Martin (US 2002/0171692 A1) in view of Mizoguchi et al. (US JP 2000-248217).

Martin teaches all that is claimed, except a rail on which the print head slides into and out of a printing position. Mizoguchi et al. teaches the print head 1100 which slides into and out a printing position as shown in Fig.2 of Mizoguchi et al., In view of the teaching of Mizoguchi et al., it would have been obvious to one of ordinary skill in the art to modify the printer of Martin by providing the rail as taught by Mizoguchi et al. for quickly mounting the print head to a printer. With respect to claim 17, the use of preheat platen is well known in the art.

### ***Allowable Subject Matter***

As presently advised it appears that claims 16, 19 and 20 avoid the prior art but are objected to as depending from a rejected claim. These claims if properly rewritten in independent form to overcome the objection and include all of the limitations of the base claim and any intervening claims and would be allowable.

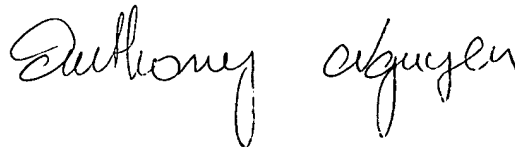
**Conclusion**

The patents to Schaede, Lehmkuhl et al., Sarda and Schmidt et al. are cited to show other structures having obvious similarities to the claimed structure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Nguyen whose telephone number is (571) 272-2169. The examiner can normally be reached daily from 9 AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld, can be reached on (571) 272-2168.

The fax phone number for this Group is (703) 872-9306.

A handwritten signature in black ink that reads "Anthony Nguyen". The signature is written in a cursive, flowing style.

Anthony Nguyen  
March 4, 2005  
Patent Examiner  
Technology Center 2800